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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,012	02/17/2005	Yoshito Tobe	1422-0663PUS1	5008

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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CUTLIFF, YATE KAI RENE

ART UNIT	PAPER NUMBER
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1609

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
31 DAYS	03/08/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 31 DAYS from 03/08/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

Application No.

10/525,012

Applicant(s)

TOBE ET AL.

Examiner

Yate K. Cutliff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

#### *Election of Species*

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species A: Any optically active compound according to formula (I) of claim 2 defined to contain individually specific functional groups with respect to each of R<sup>1</sup> wherein R<sup>1</sup> is nephtyl, anthyrl, pyrenyl or phenanthryl, R<sup>2</sup> is a hydrogen atom, R<sup>3</sup> through R<sup>10</sup> as defined in claim 2, and R<sup>11</sup> through R<sup>12</sup> is a hydrogen as defined in claim 2.

Claims 1 and 3 links inventions of Species A.

Species B: Any optically active compound according to formula (I) of claim 2 defined to contain individually specific functional groups with respect to each of R<sup>1</sup> wherein R<sup>1</sup> is benzothiazolyl , R<sup>2</sup> is a hydrogen atom, R<sup>3</sup> through R<sup>10</sup> as defined in claim 12, and R<sup>11</sup> through R<sup>12</sup> is a hydrogen as defined in claim 2.

Claims 1 and 3 links inventions of Species B.

Species C: Any optically active compound according to formula (I) of claim 2 defined to contain individually specific functional groups with respect to each of R<sup>1</sup> wherein R<sup>1</sup> is nephtyl, anthyrl, pyrenyl or phenanthryl, R<sup>2</sup> is as defined in claim 2, and

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not a hydrogen atom,  $R^3$  through  $R^{10}$  as defined in claim 12, and  $R^{11}$  through  $R^{12}$  as defined in claim 2 and not a hydrogen atom.

Claims 1 and 3 links inventions of Species C.

Species D: Any optically active compound according to formula (I) of claim 2 defined to contain individually specific functional groups with respect to each of  $R^1$  wherein  $R^1$  is benzothiazolyl,  $R^2$  as defined in claim 2 and not a hydrogen atom,  $R^3$  through  $R^{10}$  as defined in claim 12, and  $R^{11}$  through  $R^{12}$  as defined in claim 2 and not a hydrogen atom.

Claims 1 and 3 links inventions of Species D.

Species E: Any optically active compound according to formula (I) of claim 2 defined to contain individually specific functional groups with respect to each of  $R^1$  wherein  $R^1$  is aromatic ethynyl group as defined in claim 2,  $R^2$  as defined in claim 2,  $R^3$  through  $R^{10}$  as defined in claim 12, and  $R^{11}$  through  $R^{12}$  bonded and as defined in claim 2.

Claims 1 and 3 links inventions of Species E.

**Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.**

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. The claims are deemed to correspond to the species listed above in the following manner:

Species A: Claim 2 in part.

Species B: Claim 2 in part.

Species C: Claim 2 in part.

Species D: Claim 2 in part.

Species E: Claim 2 in part.

The species lack unity because they differ in elements, bonding arrangements and chemical structure to such an extent that a reference anticipating any one group would not render the other group obvious, thus unpatentability of any group would not necessarily imply unpatentability of another group. The varying classes and subclasses of each diverse structure as delineated will constitute an enormous search burden.

The following claim(s) are generic: Claims 1 and 3.

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

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Each species contains the genus of formula (I), which is the special technical feature that is shared by all of the analogous compounds. However, Kenichiro Nakashima, et al., *Talanta*, 1984, Vol. 25, No. 9, pages 749-751, teaches a compound that includes the features of applicant's genus for formula (I). Specifically, formula (I) of applicant's invention lacks an inventive step because it reads on, benzothiazolylphenol, a compound taught by Nakashima, et al., and covered by claim 2 of applicant's invention. Therefore, the technical feature linking the claims does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

Accordingly, Species A-E are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

4. Applicant is required, in reply to this action, **to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yate K. Cutliff whose telephone number is (571) 272-

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9067. The examiner can normally be reached on Monday - Thursday from 8:30 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on (571) 272 - 0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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